

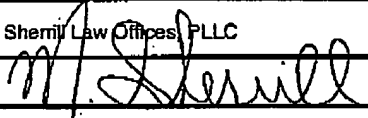
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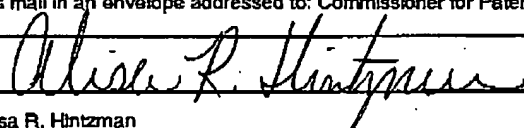
PTO/SB/21 (09-04)

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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/033,580	
	Filing Date	December 28, 2001	
	First Named Inventor	Eddy	
	Art Unit	3632	
	Examiner Name	Marsh, Steven M.	
Total Number of Pages in This Submission	25	Attorney Docket Number	EDD002USPT01

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
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Firm Name	Sherrill Law Offices PLLC	
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Printed name	Michael S. Sherrill	
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Typed or printed name	Alisa R. Hintzman	Date Feb. 3, 2005

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on February 3, 2005.

  
Alisa R. Hintzman

<b>SUPPLEMENTAL APPEAL BRIEF</b>			<b>Docket No.</b> <b>EDD002USPT01</b>
<b>Serial No.</b> 10/033,580	<b>Filing Date</b> December 28, 2001	<b>Examiner</b> Marsh, Steven M.	<b>Group Art Unit</b> 3632
<b>Applicant:</b>	Eddy		
<b>Invention:</b>	EAVES TROUGH SUPPORT BRACKET		

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

This Supplemental Appeal Brief is filed on appeal from the decision of the Examiner dated November 30, 2004 reopening prosecution of this application after Applicant's filing of an Appeal Brief and rejecting claims 1, 3-16 and 18-22 in the above-referenced patent application.

Applicant requests reinstatement of the appeal.

This Supplemental Appeal Brief is being submitted in triplicate in accordance with 35 C.F.R. 1.192(a).

**REAL PARTY IN INTEREST**

The real party in interest in connection with this appeal is the inventor Gary Eddy.

### **RELATED APPEALS AND INTERFERENCES**

Appellant and appellant's legal representative are unaware of any other appeal or interference which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

### **STATUS OF CLAIMS**

The application was filed on December 28, 2001 with claims 1-20. Claims 1, 18 and 19 were amended, claims 2 and 17 canceled and new claims 21 and 22 added in an Amendment and Response filed on December 19, 2002. Claims 1, 7, 13, 18 and 19 were amended in an Amendment and Response filed on August 26, 2003 concomitantly with the filing of a RCE. Claim 22 was amended in an Amendment and Response filed on December 12, 2003. Claims 1, 3-16 and 18-22 remain pending in the application. Claims 1, 3-16 and 18-22 have been finally rejected. No claims have been allowed.

The rejection of claims 1, 3-16 and 18-22 is appealed. A copy of the claims involved in this appeal was provided in the Appendix section of the Appeal Brief.

### **STATUS OF AMENDMENTS**

No amendment has been filed subsequent to final rejection of the appealed claims.

### **SUMMARY OF THE INVENTION**

**A First Embodiment** of the present claimed invention (claims 1, 3-16, and 18-20) is directed to an eaves trough support bracket having a first leg extending in a second transverse direction from the first edge of a main beam with a proximal longitudinal end substantially transversely aligned with a proximal end of the main beam and a second leg extending in the second transverse direction from a second edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam. The main beam, first

leg, and second leg define a concavity accessible from a first transverse direction whereby the support bracket is transversely nestable. A connection element extends in a first transverse direction from the distal end of the main beam with a longitudinally extending tab transversely spaced from the main beam in the first transverse direction a distance of about 0.4 to 0.6 inches from the first surface of the main beam.

**A Second Embodiment** of the present claimed invention (claim 21) is directed to an eaves trough support bracket having a main beam, first leg and second leg. The first and second legs extend in a second transverse direction. The first leg has a transverse height that tapers in the second transverse direction with a height at the longitudinal center of the main beam less than one half the transverse height at the proximal longitudinal end of the first leg. The second leg has a transverse height that tapers in the second transverse direction with a height at the longitudinal center of the main beam less than one half the transverse height at the proximal longitudinal end of the second leg.

**A Third Embodiment** of the present claimed invention (claim 22) is directed to an eaves trough support bracket having a main beam, connection element, first leg, second leg, a first bend line, second bend line, at least one primary rib, and at least one secondary rib. The connection element includes a strut and a tab. The at least one primary rib is formed within the main beam and the strut which extends across and substantially perpendicular to the first bend line and overlaps the first and second leg improving the strength of the bracket. The at least one secondary rib is formed within the strut and tab and extends across and substantially perpendicular to the second bend line and transversely overlaps the at least one primary rib improving the strength of the bracket.

#### ISSUES

1. Whether claims 1, 3-16 and 18-20 fail to comply with 35 U.S.C. §112, first paragraph for inclusion of new subject matter based upon the claimed limitation of "transversely nestable".

2. Whether claim 22 is indefinite for failing to show overlapping of the primary rib and the legs.

3. Whether claims 1, 3-16 and 18-22 are obvious over Odekirk (United States Patent No. 4,294,422).

#### GROUPING OF CLAIMS

1. Rejected claims 1, 3-16 and 18-20 stand or fall together with respect to the rejection under 35 U.S.C. §112, first paragraph for inclusion of new subject matter based upon the claimed limitation of "transversely nestable".

2. Rejected claims 1, 3-16 and 18-22 do NOT stand or fall together with respect to the obviousness rejection over Odekirk. The First Embodiment of the present claimed invention (claims 1, 3-16 and 18-20) is directed to nestable eaves trough support brackets having a connection element on the distal end of the main beam with a longitudinally extending tab transversely spaced from the main beam a distance of about 0.4 to 0.6 inches from the first surface of the main beam. The Second Embodiment of the present claimed invention (claim 21) is directed to eaves trough support brackets having first and second legs with transverse heights that taper in the second transverse direction, with a transverse height of each leg at the longitudinal center of the main beam which is less than one half the transverse height of that leg at the proximal longitudinal end of the leg. The Third Embodiment of the present claimed invention (claim 22) is directed to eaves trough support brackets having a primary rib which overlaps the legs.

**ARGUMENT*****Objections/Rejections  
Under 35 U.S.C. § 112***

**1.0** *The Examiner has rejected claims 1, 3-16 and 18-20 as non-enabled under ¶1.*

The First Embodiment of the present claimed invention includes a main beam, first leg, and second leg defining a concavity accessible from the first transverse direction, rendering the bracket transversely nestable. Support for the claimed invention is found in Figures 1-4. Persons skilled in the art would know and understand that the invention as shown and described in the specification is nestable by considering the size, shape and configuration of the main beam, first leg, and second leg. While the Figures and written description do not expressly illustrate or describe the brackets in a nested configuration, Figures 1-4 clearly illustrate a bracket with the inherent function of nestability. Therefore, the function of nestability is inherently disclosed in the specification and recitation of this inherent function in the claims does not introduce new matter. See, M.P.E.P. §2163.07(a) [INHERENT FUNCTION, THEORY OR ADVANTAGE].

**2.0** *The Examiner has objected to claim 22 as indefinite for failing to show overlapping of the primary rib and the legs.*

Applicant respectfully disagrees that claim 22 is indefinite. Claim 22 recites "at least one primary rib formed within the main beam and the strut which ... (ii) *longitudinally* overlaps the first leg and the second leg ..." (Emphasis Added). Figures 1-4 and 5 support this claimed element. Referring to Figure 2, the rib (131) clearly longitudinally overlaps the first leg (110) as the rib (131) has a longitudinal length that starts proximate the strut (40) and the distal longitudinal end (112) of the first leg (110) and runs in the second longitudinal direction ( $x^2$ ) toward the proximal longitudinal end (111) of the first leg (110). Hence, the rib longitudinally overlaps the first leg.

**Objections/Rejections**  
**Under 35 U.S.C. §103**

**3.0** The Examiner has rejected claims 1, 3-16 and 18-22 as obvious over Odekirk (United States Patent No. 4,294,422).

**SUMMARY OF CITED REFERENCES**

Odekirk discloses an eaves trough support bracket comprising a longitudinally elongated main beam, a first longitudinally elongated side rib extending along a first side of the main beam, and a second longitudinally elongated side rib extending along a second side of the main beam. A connection element comprising a strut [62] and a tab [60] is provided at the longitudinal distal end of the main beam for attaching the bracket to channel on the forward face of a gutter. The strut extends upward from the main beam while the tab extends longitudinally from the strut. A clip [70] is provided at the longitudinal proximal end of the main beam for sliding engagement over the back sidewall of the gutter and accommodating passage of a nail through the clip and into a fascia board. The clip extends transversely above the top of the main beam and below the bottom of the side ribs. A rib is provided across the bend line between the main beam and the strut. The first and second side ribs extend from the main beam in a second transverse direction with the transverse height of the side ribs remaining substantially unchanged along the entire longitudinal length of the bracket.

**LEGAL BASIS**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See, M.P.E.P. § 2143.

As to the first criteria, it is necessary to ascertain whether or not the reference motivates one of ordinary skill in the relevant art, having the reference before him, to make the proposed substitution,

combination, or modification. In re Linter, 458 F.2d 1013, 173 U.S.P.Q. 560, 562 (CCPA 1972). Obviousness can only be established where there is some teaching, suggestion or motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art, to combine the references and produce the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q. 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See, M.P.E.P. § 2143.01.

#### FIRST EMBODIMENT

The First Embodiment of the present claimed invention is directed to an eaves trough support bracket which is nestable. The eaves trough support bracket disclosed by Odekirk is NOT nestable. The combination of (i) an unnestable clip [70] at one end of the main beam which extends transversely above the main beam and below the side ribs, (ii) an unnestable transversely extending connection element [60 and 62] at the other end of the main beam, and (iii) side ribs which extend only a short distance from the main beam, renders the entire bracket unnestable.

#### SECOND EMBODIMENT

The Second Embodiment of the present claimed invention is directed to an eaves trough support bracket having legs with a transversely tapered height with a height at the longitudinal center of the main beam which is less than one half the transverse height at the proximal longitudinal end of the first leg. Odekirk discloses a gutter bracket with legs having an extremely short and uniform transverse height along the entire length of the main beam.

#### THIRD EMBODIMENT

The Third Embodiment of the present claimed invention is directed to a bracket with a primary rib which extends across and is substantially perpendicular to the bend line between the distal end of the main beam and the strut. The primary rib is configured and arranged so that the primary rib longitudinally overlaps the first and second legs so as to further improve the strength of the bracket. While the eaves trough support bracket disclosed by Odekirk also has a rib which extends across and is substantially perpendicular to the bend line between the distal end of the



main beam and the strut, this rib does not longitudinally overlap the side ribs, as can clearly be seen in FIG 1.

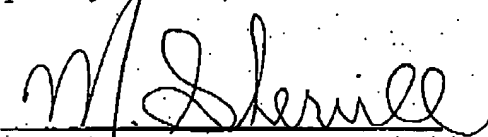
### CONCLUSION

Applicant respectfully submits that all pending claims (claims 1, 3-16 and 18-22) are in condition for allowance.

Respectfully submitted,

Date 03 Feb 05

By




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Alisa R. Hintzman

<b>SUPPLEMENTAL APPEAL BRIEF</b>			Docket No. <b>EDD002USPT01</b>
Serial No. <b>10/033,580</b>	Filing Date <b>December 28, 2001</b>	Examiner <b>Marsh, Steven M.</b>	Group Art Unit <b>3632</b>
Applicant:	<b>Eddy</b>		
Invention:	<b>EAVES TROUGH SUPPORT BRACKET</b>		

**Mail Stop Appeal Brief - Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Supplemental Appeal Brief is filed on appeal from the decision of the Examiner dated November 30, 2004 reopening prosecution of this application after Applicant's filing of an Appeal Brief and rejecting claims 1, 3-16 and 18-22 in the above-referenced patent application.

Applicant requests reinstatement of the appeal.

This Supplemental Appeal Brief is being submitted in triplicate in accordance with 35 C.F.R. 1.192(a).

**REAL PARTY IN INTEREST**

The real party in interest in connection with this appeal is the inventor Gary Eddy.

**RELATED APPEALS AND INTERFERENCES**

Appellant and appellant's legal representative are unaware of any other appeal or interference which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

**STATUS OF CLAIMS**

The application was filed on December 28, 2001 with claims 1-20. Claims 1, 18 and 19 were amended, claims 2 and 17 canceled and new claims 21 and 22 added in an Amendment and Response filed on December 19, 2002. Claims 1, 7, 13, 18 and 19 were amended in an Amendment and Response filed on August 26, 2003 concomitantly with the filing of a RCE. Claim 22 was amended in an Amendment and Response filed on December 12, 2003. Claims 1, 3-16 and 18-22 remain pending in the application. Claims 1, 3-16 and 18-22 have been finally rejected. No claims have been allowed.

The rejection of claims 1, 3-16 and 18-22 is appealed. A copy of the claims involved in this appeal was provided in the Appendix section of the Appeal Brief.

**STATUS OF AMENDMENTS**

No amendment has been filed subsequent to final rejection of the appealed claims.

**SUMMARY OF THE INVENTION**

A **First Embodiment** of the present claimed invention (claims 1, 3-16, and 18-20) is directed to an eaves trough support bracket having a first leg extending in a second transverse direction from the first edge of a main beam with a proximal longitudinal end substantially transversely aligned with a proximal end of the main beam and a second leg extending in the second transverse direction from a second edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam. The main beam, first

leg, and second leg define a concavity accessible from a first transverse direction whereby the support bracket is transversely nestable. A connection element extends in a first transverse direction from the distal end of the main beam with a longitudinally extending tab transversely spaced from the main beam in the first transverse direction a distance of about 0.4 to 0.6 inches from the first surface of the main beam.

A Second Embodiment of the present claimed invention (claim 21) is directed to an eaves trough support bracket having a main beam, first leg and second leg. The first and second legs extend in a second transverse direction. The first leg has a transverse height that tapers in the second transverse direction with a height at the longitudinal center of the main beam less than one half the transverse height at the proximal longitudinal end of the first leg. The second leg has a transverse height that tapers in the second transverse direction with a height at the longitudinal center of the main beam less than one half the transverse height at the proximal longitudinal end of the second leg.

A Third Embodiment of the present claimed invention (claim 22) is directed to an eaves trough support bracket having a main beam, connection element, first leg, second leg, a first bend line, second bend line, at least one primary rib, and at least one secondary rib. The connection element includes a strut and a tab. The at least one primary rib is formed within the main beam and the strut which extends across and substantially perpendicular to the first bend line and overlaps the first and second leg improving the strength of the bracket. The at least one secondary rib is formed within the strut and tab and extends across and substantially perpendicular to the second bend line and transversely overlaps the at least one primary rib improving the strength of the bracket.

#### ISSUES

1. Whether claims 1, 3-16 and 18-20 fail to comply with 35 U.S.C. §112, first paragraph for inclusion of new subject matter based upon the claimed limitation of "transversely nestable".

2. Whether claim 22 is indefinite for failing to show overlapping of the primary rib and the legs.

3. Whether claims 1, 3-16 and 18-22 are obvious over Odekirk (United States Patent No. 4,294,422).

#### GROUPING OF CLAIMS

1. Rejected claims 1, 3-16 and 18-20 stand or fall together with respect to the rejection under 35 U.S.C. §112, first paragraph for inclusion of new subject matter based upon the claimed limitation of "transversely nestable".

2. Rejected claims 1, 3-16 and 18-22 do NOT stand or fall together with respect to the obviousness rejection over Odekirk. The First Embodiment of the present claimed invention (claims 1, 3-16 and 18-20) is directed to nestable eaves trough support brackets having a connection element on the distal end of the main beam with a longitudinally extending tab transversely spaced from the main beam a distance of about 0.4 to 0.6 inches from the first surface of the main beam. The Second Embodiment of the present claimed invention (claim 21) is directed to eaves trough support brackets having first and second legs with transverse heights that taper in the second transverse direction, with a transverse height of each leg at the longitudinal center of the main beam which is less than one half the transverse height of that leg at the proximal longitudinal end of the leg. The Third Embodiment of the present claimed invention (claim 22) is directed to eaves trough support brackets having a primary rib which overlaps the legs.

## ARGUMENT

### *Objections/Rejections Under 35 U.S.C. § 112*

*1.0 The Examiner has rejected claims 1, 3-16 and 18-20 as non-enabled under ¶1.*

The First Embodiment of the present claimed invention includes a main beam, first leg, and second leg defining a concavity accessible from the first transverse direction, rendering the bracket transversely nestable. Support for the claimed invention is found in Figures 1-4. Persons skilled in the art would know and understand that the invention as shown and described in the specification is nestable by considering the size, shape and configuration of the main beam, first leg, and second leg. While the Figures and written description do not expressly illustrate or describe the brackets in a nested configuration, Figures 1-4 clearly illustrate a bracket with the inherent function of nestability. Therefore, the function of nestability is inherently disclosed in the specification and recitation of this inherent function in the claims does not introduce new matter. See, M.P.E.P. §2163.07(a) [INHERENT FUNCTION, THEORY OR ADVANTAGE].

*2.0 The Examiner has objected to claim 22 as indefinite for failing to show overlapping of the primary rib and the legs.*

Applicant respectfully disagrees that claim 22 is indefinite. Claim 22 recites "at least one primary rib formed within the main beam and the strut which ... (ii) *longitudinally* overlaps the first leg and the second leg ..." (Emphasis Added). Figures 1-4 and 5 support this claimed element. Referring to Figure 2, the rib (131) clearly longitudinally overlaps the first leg (110) as the rib (131) has a longitudinal length that starts proximate the strut (40) and the distal longitudinal end (112) of the first leg (110) and runs in the second longitudinal direction ( $x^2$ ) toward the proximal longitudinal end (111) of the first leg (110). Hence, the rib longitudinally overlaps the first leg.

***Objections/Rejections***  
**Under 35 U.S.C. §103**

**3.0** The Examiner has rejected claims 1, 3-16 and 18-22 as obvious over Odekirk (*United States Patent No. 4,294,422*).

**SUMMARY OF CITED REFERENCES**

Odekirk discloses an eaves trough support bracket comprising a longitudinally elongated main beam, a first longitudinally elongated side rib extending along a first side of the main beam, and a second longitudinally elongated side rib extending along a second side of the main beam. A connection element comprising a strut [62] and a tab [60] is provided at the longitudinal distal end of the main beam for attaching the bracket to channel on the forward face of a gutter. The strut extends upward from the main beam while the tab extends longitudinally from the strut. A clip [70] is provided at the longitudinal proximal end of the main beam for sliding engagement over the back sidewall of the gutter and accommodating passage of a nail through the clip and into a fascia board. The clip extends transversely above the top of the main beam and below the bottom of the side ribs. A rib is provided across the bend line between the main beam and the strut. The first and second side ribs extend from the main beam in a second transverse direction with the transverse height of the side ribs remaining substantially unchanged along the entire longitudinal length of the bracket.

**LEGAL BASIS**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See, M.P.E.P. § 2143.

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#### FIRST EMBODIMENT

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The Second Embodiment of the present claimed invention is directed to an eaves trough support bracket having legs with a transversely tapered height with a height at the longitudinal center of the main beam which is less than one half the transverse height at the proximal longitudinal end of the first leg. Odekirk discloses a gutter bracket with legs having an extremely short and uniform transverse height along the entire length of the main beam.

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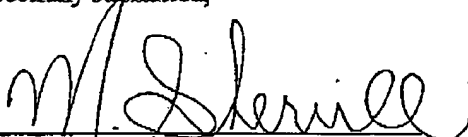
### CONCLUSION

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Respectfully submitted,

Date 03 Feb 05

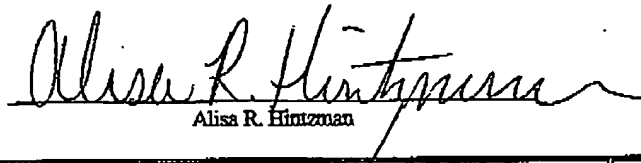
By



Michael S. Sherrill, #32,302  
SHERRILL LAW OFFICES, PLLC  
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### RELATED APPEALS AND INTERFERENCES

Appellant and appellant's legal representative are unaware of any other appeal or interference which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

### STATUS OF CLAIMS

The application was filed on December 28, 2001 with claims 1-20. Claims 1, 18 and 19 were amended, claims 2 and 17 canceled and new claims 21 and 22 added in an Amendment and Response filed on December 19, 2002. Claims 1, 7, 13, 18 and 19 were amended in an Amendment and Response filed on August 26, 2003 concomitantly with the filing of a RCE. Claim 22 was amended in an Amendment and Response filed on December 12, 2003. Claims 1, 3-16 and 18-22 remain pending in the application. Claims 1, 3-16 and 18-22 have been finally rejected. No claims have been allowed.

The rejection of claims 1, 3-16 and 18-22 is appealed. A copy of the claims involved in this appeal was provided in the Appendix section of the Appeal Brief.

### STATUS OF AMENDMENTS

No amendment has been filed subsequent to final rejection of the appealed claims.

### SUMMARY OF THE INVENTION

A First Embodiment of the present claimed invention (claims 1, 3-16, and 18-20) is directed to an eaves trough support bracket having a first leg extending in a second transverse direction from the first edge of a main beam with a proximal longitudinal end substantially transversely aligned with a proximal end of the main beam and a second leg extending in the second transverse direction from a second edge of the main beam with a proximal longitudinal end substantially transversely aligned with the proximal end of the main beam. The main beam, first

leg, and second leg define a concavity accessible from a first transverse direction whereby the support bracket is transversely nestable. A connection element extends in a first transverse direction from the distal end of the main beam with a longitudinally extending tab transversely spaced from the main beam in the first transverse direction a distance of about 0.4 to 0.6 inches from the first surface of the main beam.

**A Second Embodiment** of the present claimed invention (claim 21) is directed to an eaves trough support bracket having a main beam, first leg and second leg. The first and second legs extend in a second transverse direction. The first leg has a transverse height that tapers in the second transverse direction with a height at the longitudinal center of the main beam less than one half the transverse height at the proximal longitudinal end of the first leg. The second leg has a transverse height that tapers in the second transverse direction with a height at the longitudinal center of the main beam less than one half the transverse height at the proximal longitudinal end of the second leg.

**A Third Embodiment** of the present claimed invention (claim 22) is directed to an eaves trough support bracket having a main beam, connection element, first leg, second leg, a first bend line, second bend line, at least one primary rib, and at least one secondary rib. The connection element includes a strut and a tab. The at least one primary rib is formed within the main beam and the strut which extends across and substantially perpendicular to the first bend line and overlaps the first and second leg improving the strength of the bracket. The at least one secondary rib is formed within the strut and tab and extends across and substantially perpendicular to the second bend line and transversely overlaps the at least one primary rib improving the strength of the bracket.

#### ISSUES

1. Whether claims 1, 3-16 and 18-20 fail to comply with 35 U.S.C. §112, first paragraph for inclusion of new subject matter based upon the claimed limitation of "transversely nestable".

2. Whether claim 22 is indefinite for failing to show overlapping of the primary rib and the legs.

3. Whether claims 1, 3-16 and 18-22 are obvious over Odekirk (United States Patent No. 4,294,422).

#### GROUPING OF CLAIMS

1. Rejected claims 1, 3-16 and 18-20 stand or fall together with respect to the rejection under 35 U.S.C. §112, first paragraph for inclusion of new subject matter based upon the claimed limitation of "transversely nestable".

2. Rejected claims 1, 3-16 and 18-22 do NOT stand or fall together with respect to the obviousness rejection over Odekirk. The First Embodiment of the present claimed invention (claims 1, 3-16 and 18-20) is directed to nestable eaves trough support brackets having a connection element on the distal end of the main beam with a longitudinally extending tab transversely spaced from the main beam a distance of about 0.4 to 0.6 inches from the first surface of the main beam. The Second Embodiment of the present claimed invention (claim 21) is directed to eaves trough support brackets having first and second legs with transverse heights that taper in the second transverse direction, with a transverse height of each leg at the longitudinal center of the main beam which is less than one half the transverse height of that leg at the proximal longitudinal end of the leg. The Third Embodiment of the present claimed invention (claim 22) is directed to eaves trough support brackets having a primary rib which overlaps the legs.

## ARGUMENT

### *Objections/Rejections Under 35 U.S.C. § 112*

*1.0 The Examiner has rejected claims 1, 3-16 and 18-20 as non-enabled under ¶1.*

The First Embodiment of the present claimed invention includes a main beam, first leg, and second leg defining a concavity accessible from the first transverse direction, rendering the bracket transversely nestable. Support for the claimed invention is found in Figures 1-4. Persons skilled in the art would know and understand that the invention as shown and described in the specification is nestable by considering the size, shape and configuration of the main beam, first leg, and second leg. While the Figures and written description do not expressly illustrate or describe the brackets in a nested configuration, Figures 1-4 clearly illustrate a bracket with the inherent function of nestability. Therefore, the function of nestability is inherently disclosed in the specification and recitation of this inherent function in the claims does not introduce new matter. See, M.P.E.P. §2163.07(a) [INHERENT FUNCTION, THEORY OR ADVANTAGE].

*2.0 The Examiner has objected to claim 22 as indefinite for failing to show overlapping of the primary rib and the legs.*

Applicant respectfully disagrees that claim 22 is indefinite. Claim 22 recites "at least one primary rib formed within the main beam and the strut which ... (ii) *longitudinally* overlaps the first leg and the second leg ..." (Emphasis Added). Figures 1-4 and 5 support this claimed element. Referring to Figure 2, the rib (131) clearly longitudinally overlaps the first leg (110) as the rib (131) has a longitudinal length that starts proximate the strut (40) and the distal longitudinal end (112) of the first leg (110) and runs in the second longitudinal direction ( $x^2$ ) toward the proximal longitudinal end (111) of the first leg (110). Hence, the rib longitudinally overlaps the first leg.

***Objections/Rejections***  
**Under 35 U.S.C. §103**

**3.0** *The Examiner has rejected claims 1, 3-16 and 18-22 as obvious over Odekirk (United States Patent No. 4,294,422).*

**SUMMARY OF CITED REFERENCES**

Odekirk discloses an eaves trough support bracket comprising a longitudinally elongated main beam, a first longitudinally elongated side rib extending along a first side of the main beam, and a second longitudinally elongated side rib extending along a second side of the main beam. A connection element comprising a strut [62] and a tab [60] is provided at the longitudinal distal end of the main beam for attaching the bracket to channel on the forward face of a gutter. The strut extends upward from the main beam while the tab extends longitudinally from the strut. A clip [70] is provided at the longitudinal proximal end of the main beam for sliding engagement over the back sidewall of the gutter and accommodating passage of a nail through the clip and into a fascia board. The clip extends transversely above the top of the main beam and below the bottom of the side ribs. A rib is provided across the bend line between the main beam and the strut. The first and second side ribs extend from the main beam in a second transverse direction with the transverse height of the side ribs remaining substantially unchanged along the entire longitudinal length of the bracket.

**LEGAL BASIS**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, NOT in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). *See*, M.P.E.P. § 2143.

As to the first criteria, it is necessary to ascertain whether or not the reference motivates one of ordinary skill in the relevant art, having the reference before him, to make the proposed substitution,

combination, or modification. In re Linter, 458 F.2d 1013, 173 U.S.P.Q. 560; 562 (CCPA 1972). Obviousness can only be established where there is some teaching, suggestion or motivation in the prior art or in the knowledge generally available to one of ordinary skill in the art, to combine the references and produce the claimed invention. In re Fine, 837 F.2d 1071, 5 U.S.P.Q. 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See, M.P.E.P. § 2143.01.

#### FIRST EMBODIMENT

The First Embodiment of the present claimed invention is directed to an eaves trough support bracket which is nestable. The eaves trough support bracket disclosed by Odekirk is NOT nestable. The combination of (i) an unnestable clip [70] at one end of the main beam which extends transversely above the main beam and below the side ribs, (ii) an unnestable transversely extending connection element [60 and 62] at the other end of the main beam, and (iii) side ribs which extend only a short distance from the main beam, renders the entire bracket unnestable.

#### SECOND EMBODIMENT

The Second Embodiment of the present claimed invention is directed to an eaves trough support bracket having legs with a transversely tapered height with a height at the longitudinal center of the main beam which is less than one half the transverse height at the proximal longitudinal end of the first leg. Odekirk discloses a gutter bracket with legs having an extremely short and uniform transverse height along the entire length of the main beam.

#### THIRD EMBODIMENT

The Third Embodiment of the present claimed invention is directed to a bracket with a primary rib which extends across and is substantially perpendicular to the bend line between the distal end of the main beam and the strut. The primary rib is configured and arranged so that the primary rib longitudinally overlaps the first and second legs so as to further improve the strength of the bracket. While the eaves trough support bracket disclosed by Odekirk also has a rib which extends across and is substantially perpendicular to the bend line between the distal end of the



main beam and the strut, this rib does not longitudinally overlap the side ribs, as can clearly be seen in FIG 1.

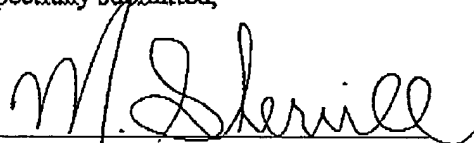
### CONCLUSION

Applicant respectfully submits that all pending claims (claims 1, 3-16 and 18-22) are in condition for allowance.

Respectfully submitted,

Date 03 Feb 05

By



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